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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85528202
Applicant	Grain Audio, LLC
Applied for Mark	GRAIN AUDIO
Correspondence Address	ROBERT W SMITH MCCARTER & ENGLISH LLP 100 MULBERRY STREET, FOUR GATEWAY CENTER NEWARK, NJ 07102-4056 UNITED STATES rsmith@mccarter.com, kgarrone@mccarter.com, dpopovic@mccarter.com
Submission	Petition To The Director To Reopen Application Pursuant To 37 C.F.R. Â§2.142(g) And Request For Amendment Of Application
Attachments	Petition to Director to Reopen Application and Request for Amendment of Application.pdf(287235 bytes )
Filer's Name	Michael R. Friscia
Filer's e-mail	mfriscia@mccarter.com, kgarrone@mccarter.com, dpopovic@mccarter.com
Signature	/Michael R. Friscia/
Date	01/21/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Grain Audio, LLC

MARK : GRAIN AUDIO

SERIAL NO. : 85/528,202

CLASS: : 9

**PETITION TO THE DIRECTOR TO REOPEN APPLICATION  
PURSUANT TO 37 C.F.R. § 2.142(g) AND REQUEST FOR AMENDMENT  
OF APPLICATION**

Applicant Grain Audio, LLC (“Applicant”) hereby submits this Petition to the Director to reopen prosecution on Applicant’s trademark application Serial No. 85/528,202, for the mark GRAIN AUDIO (the “Application”), pursuant to 37 C.F.R. § 2.142(g), and requests an amendment of its Application to delete certain goods. As set forth in detail below, sufficient cause exists for consideration of matter not already adjudicated, because the issue of whether the GRAIN AUDIO mark is registrable for just the amended goods has not yet been adjudicated, and Applicant seeks to delete certain goods from its Application that render the Application in condition for publication without further examination or additional searching.

**Statement of Facts**

Applicant filed the Application under Trademark Act Section 1(b) on January 30, 2012, based on an intent to use the mark GRAIN AUDIO in connection with the following goods:

audio speakers, audio amplifiers, audio receivers, audio mixers,  
audio decoders, speakers, compact disc players, MP3  
controllers/players, microphones, audio speakers in the nature of  
music studio monitors, phonographic record players, audio  
recording equipment, digital LP converters, wireless speakers,  
wireless audio players, portable audio players, portable speakers,

powered speakers, and bookshelf speakers, in International Class 9;

which was subsequently amended to the following:

audio speakers, audio amplifiers, audio receivers, audio mixers, audio decoders, speakers, compact disc players, MP3 controllers, MP3 players, microphones, audio speakers in the nature of music studio monitors, phonographic record players, audio recording equipment, namely audio recorders, digital LP converters, wireless speakers, wireless audio players, portable audio players, portable speakers, powered speakers, and bookshelf speakers, in International Class 9;

(the "Applicant's Mark"). On May 14, 2012, the Examining Attorney issued a Non-Final Office Action refusing registration of the Applicant's Mark under Trademark Act Section 2(d) on the basis that the mark is likely to cause confusion with the mark EGRAIN, Registration No.

2,966,216, covering the following goods and services:

data processing apparatus and systems, namely, computers and computer networks comprising functional electronic units with electronic circuit substrates; autarchic miniaturized microcomputers capable of build-up and organizing a network autonomously by themselves through wireless communication; microprocessors, computer memories, application-specific integrated circuits (asics); radio frequency (rf) receiver and sender, sensor circuit computer hardware; computer peripherals; electronic display panels and electronic display devices, namely, light-emitting diodes (led's); organic light emitting diodes (oled's); liquid crystal displays (lcd's); computer interface boards; transmitters and receivers for telecommunications, namely, radio transmitters, audio receivers; telephone receivers; transmitters and receivers for electronic, analog, and digital signals, namely, television, radio (rf); network software, namely, network access server operating software, in International Class 9, and

research and development on electronics, microelectronics, and informatics, namely, on the informatics of operating systems and of parallel decentralized data processing; design and development of computers, computer networks, namely, body area networks and computer programs, all for others,

in International Class 42 (the "Cited Registration"), owned by Fraunhofer-Gesellschaft zur

Forderung der angewandten Forschung e.V. (the “Registrant”).<sup>1</sup>

On October 12, 2012, the Applicant submitted arguments and evidence in response to the Non-Final Office Action, asserting, *inter alia*, that confusion is not likely because the appearance, sound, meaning, and overall commercial impressions of the Applicant’s Mark and the Cited Registration are different, the marks cover different goods that are not closely related and are likely sold in different channels of trade to customers with different needs, and the goods covered by the marks are relatively expensive and will be purchased by discriminating and sophisticated purchasers.

On November 6, 2012, the Examining Attorney issued a Final Office Action maintaining the refusal based on the Cited Registration notwithstanding Applicant’s arguments and evidence against the refusal.

On April 16, 2013, Applicant filed an ex parte appeal of the Examining Attorney’s refusal to register the Applicant’s Mark to the Trademark Trial and Appeal Board. On June 11, 2013, Applicant submitted its brief in support of the appeal, on August 13, 2013, the Examining Attorney submitted a responsive brief, and on August 30, 2013, Applicant submitted its reply brief.

On November 22, 2013, the Board issued a decision affirming the Examining Attorney’s refusal to register the Applicant’s Mark. In determining that confusion between the Applicant’s Mark and the Cited Registration was likely, the Board focused in large part on the fact that the Cited Registration listed “transmitters and receivers for telecommunications, namely, radio

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<sup>1</sup> The Examining Attorney had also cited the prior registered marks FILM GRAIN TECHNOLOGY, U.S. Registration No. 3,342,337 and FILM GRAIN TECHNOLOGY (& Design), U.S. Registration No. 3,468,040 as likely to be confused with the Applicant’s Mark. However, the Examining Attorney withdrew the refusal based on these registrations in the Final Office Action.

transmitters, audio receivers” and the Application listed “audio receivers,” finding that these goods were “legally identical.” In re Grain Audio, LLC, Serial No. 85/528,202 (TTAB November 22, 2013) at 6 – 7.

The Board also noted that some of Applicant’s goods were related to the “computer peripherals” listed in the Cited Registration. In particular, the Board noted that website printouts submitted by the Examining Attorney established that “some ‘computer peripherals’ were related to applicant’s goods, such as computer speakers and microphones, and other audio-focused products that interact with computers.” Id. at 7. The Board concluded that confusion between the Applicant’s Mark and the Cited Registration was likely.

Applicant hereby requests that the Director reopen prosecution of the Application to consider amendments to the Applicant’s identification of goods, which would remove any conflict with the Cited Registration. The Applicant requests an amendment of its Application to delete the following goods:

audio amplifiers, audio receivers, audio mixers, audio decoders, speakers, compact disc players, MP3 controllers, MP3 players, microphones, audio speakers in the nature of music studio monitors, audio recording equipment, namely audio recorders, digital LP converters, wireless speakers, wireless audio players, portable audio players, portable speakers, and powered speakers.

The Application as amended would cover only the following goods: “audio speakers, phonographic record players, and bookshelf speakers” (the “Amended Goods”).

### **Points to be Reviewed and Action or Relief Requested**

Applicant respectfully requests that the Director grant Applicant's petition to reopen prosecution of the Application so the Examining Attorney can enter the Applicant's proposed amendments to its Application. Applicant submits that the Application as amended does not conflict with the Cited Registration and that the Application incorporating the Amended Goods would be in condition for publication.

"After a decision on appeal, the applicant may petition the Director under 37 C.F.R. §2.142(g) to reopen prosecution of the application." Trademark Manual of Examining Procedure, Fourth Edition (April 2005) at §1501.06. If the Director grants the petition, jurisdiction is restored to the examining attorney to take the specified action. Id. Section 1218 of the Trademark Trial and Appeal Board Manual of Procedure provides that an "application may be reopened upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated." Trademark Trial and Appeal Board Manual of Procedure, 3d ed., rev. 2 (June 2013), §1218, citing 37 C.F.R. §2.142(g).

Sufficient cause exists to reopen prosecution of the Application to consider matters not already adjudicated. There has been no adverse decision on the Application as amended and therefore the registrability of the GRAIN AUDIO mark in connection with just the Amended Goods has not yet been adjudicated. In considering whether or not Applicant's petition to reopen the Application to consider an amendment should be granted, the Director should consider that the Applicant's Mark, subject only to an updating search, is ready for publication for opposition without further examination by the Examining Attorney. See In re Hickory Manufacturing Co.,

183 U.S.P.Q. 789 (Comm'r Pats. 1974) (granting petition to reopen prosecution of application where application as amended was ready for publication, subject to an updating search). The Applicant seeks only to delete certain goods in the Application, not to change wording in the Applicant's identification of goods or to undertake any other amendments that would require further substantive examination of the Application by the Examining Attorney. In addition, as the amendments would only remove goods from the Application, additional searching would not be required.

Significantly, the Applicant seeks to delete "audio receivers" from its Application, as well as "microphones" and all other arguably audio-focused products that interact with computers. Given that the Board's decision was primarily based on the argument that "audio receivers" were legally identical to goods listed in the registration for the Cited Mark and that other products that interact with computers listed in the Application were related to the goods listed in the Cited Registration, Applicant respectfully submits deleting these goods from the Application removes any basis for a refusal based on likelihood of confusion. Consequently, in view of the Applicant's proposed amendments, it is respectfully requested that the Examining Attorney withdraw its refusal to register the Applicant's Mark as amended and approve the Amended Application for publication without further review or searching.

### **Conclusion**

Based on the foregoing, Applicant respectfully requests that the Director grant the Applicant's petition and allow the Examining Attorney to enter the Applicant's proposed amendment to the Application, which would place the Application in condition for publication without further searching or examination.

Respectfully submitted,

**McCARTER & ENGLISH, LLP**  
Attorneys for Applicant Grain Audio, LLC

By: Michael R. Friscia  
Michael R. Friscia

Dated: January 21, 2014